

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Raymond G. Schuder et al. Art Unit : 3722
Serial No. : 10/820,649 Examiner : Gates, Eric Andrew
Filed : 4/7/04 Confirmation No.: 8492
Title : SYSTEMS AND METHODS OF ATTACHING A COVER TO A TEXT
BODY

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas.

II. Related Appeals and Interferences

Appellant is not aware of any related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 9-13, 21-30, and 36-39 are pending. Of these claims, claims 9-13, 21-24, 27-30, and 36-39 stand rejected, and claims 25 and 26 stand allowed.

Claims 1-8, 14-20, and 31-35 have been canceled.

Appellant appeals all rejections of the pending rejected claims 9-13, 21-24, 27-30, and 36-39.

CERTIFICATE OF TRANSMISSION

I hereby certify that this document is being transmitted to the Patent and Trademark Office via electronic filing.

September 15, 2008

Date of Transmission

/Edouard Garcia, Reg. No. 38,461/
(Signature of person mailing papers)

Edouard Garcia
(Typed or printed name of person mailing papers)

Applicant : Raymond G. Schuder et al.
Serial No. : 10/820,649
Filed : April 7, 2004
Page : 2 of 22

Attorney's Docket No.: 10002621-2
Appeal Brief dated Sep. 15, 2008
Reply to final action dated Apr. 14, 2008

IV. Status of Amendments

The amendments filed February 7, 2008, have been entered and acted upon by the Examiner.

No amendments were filed after the final Office action dated April 14, 2008.

V. Summary of Claimed Subject Matter

A. Independent claim 9

The aspect of the invention defined in independent claim 9 is a bookbinding system that comprises a sheet binder, an adhesive dispenser, and a cover binder (page 7, lines 12-13 and 20-22; page 9, lines 7-10; FIGS. 1 and 7A). The sheet binder is configured to bind with an adhesive two or more sheets (page 7, lines 20-21) into an adhesively bound text body having an exposed spine bounded by two exposed side hinge areas (FIG. 2; page 7, line 30 - page 8, line 3). The adhesive dispenser is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body (page 8, lines 14-32). The cover binder is configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (page 8, lines 22-24).

B. Dependent claim 11

Claim 11 depends from claim 9 and recites that the adhesive dispenser comprises a plug-in cartridge housing (page 9, lines 7-10; FIG. 7A).

C. Dependent claim 12

Claim 12 depends from claim 11 and recites that the adhesive dispenser comprises a supply spool disposed within the plug-in cartridge housing and configured to support a roll of pressure sensitive adhesive tape formed from a solid pressure sensitive adhesive film disposed on a carrier ribbon (page 9, lines 12-29; FIGS. 7A and 7B).

D. Dependent claim 13

Claim 13 depends from claim 12 and recites that the adhesive dispenser comprises a take-up spool disposed within the plug-in cartridge housing and configured to reel-in spent carrier ribbon (page 9, lines 13-26; FIGS. 7A and 7B).

E. Independent claim 30

The aspect of the invention defined in independent claim 30 is a bookbinding system that comprises a sheet binder, an adhesive dispenser, and a cover binder (page 7, lines 12-13 and 20-22; page 9, lines 7-10; FIGS. 1 and 7A). The sheet binder configured to bind two or more sheets (page 7, lines 20-21) into a text body having an exposed spine bounded by two exposed side hinge areas (page 7, line 30 - page 8, line 3; FIG. 2). The adhesive dispenser is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body (page 8, lines 14-32). The adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon (page 9, lines 14-17). The adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon (page 9, lines 18-29). The cover binder is configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (page 8, lines 22-24).

VI. Grounds of Rejection to be Reviewed on Appeal

- A. Claims 9, 10, 21-24, 27-29, 36, 37, and 39 stand rejected under 35 U.S.C. § 103(a) over Watson (U.S. 3,847,718) in view of Card (U.S. 3,739,412).
- B. Claim 11 stands rejected under 35 U.S.C. § 103(a) over Watson (U.S. 3,847,718) in view of Card (U.S. 3,739,412) and Nakamura (JP 05038891).
- C. Claims 12, 13, and 30 stand rejected under 35 U.S.C. § 103(a) over Watson (U.S. 3,847,718) in view of Card (U.S. 3,739,412), Nakamura (JP 05038891), and Rossini (U.S. 5,261,996).

VII. Argument

A. Applicable standards for sustaining a rejection under 35 U.S.C. § 103(a)

“A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. §103(a).

In an appeal involving a rejection under 35 U.S.C. § 103, an examiner bears the initial burden of establishing *prima facie* obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To support a *prima facie* conclusion of obviousness, the prior art must disclose or suggest all the limitations of the claimed invention.¹ See In re Lowry, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994). If the examiner has established a *prima facie* case of obviousness, the burden of going forward then shifts to the applicant to overcome the *prima facie* case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. This inquiry requires (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. See KSR Int'l Co. v. Teleflex Inc., No. 127 S. Ct. 1727, 1728 (2007) (citing Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966)). If all claim limitations are found in a number of prior art references, the fact finder must determine whether there was an apparent reason to combine the known elements in the fashion claimed. See KSR, 1741. This analysis should be made explicit. KSR at 1741 (citing In re Kahn, 441 F. 3d 977, 988 (Fed. Cir. 2006): “[R]ejections on obviousness grounds cannot be sustained

¹ The U.S. Patent and Trademark Office has set forth the following definition of the requirements for establishing a *prima facie* case of unpatentability (37 CFR § 1.56(b)(ii)):

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

B. Rejection of claims 9, 10, 21-24, 27-29, 36, 37, and 39 under 35 U.S.C. § 103(a) over Watson in view of Card

The Examiner has rejected claims 9, 10, 21-24, 27-29, 36, 37, and 39 under 35 U.S.C. § 103(a) over Watson (U.S. 3,847,718) in view of Card (U.S. 3,739,412).

1. Independent claim 9

a. Introduction

Independent claim 9 recites:

Claim 9: A bookbinding system, comprising:

a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body having an exposed spine bounded by two exposed side hinge areas;

an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and

a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

The rejection of independent claim 9 under 35 U.S.C. § 103(a) over Watson in view of Card should be withdrawn because Watson and Card, taken either alone or in any permissible combination, do not disclose or suggest all the elements of the claimed invention. The rejection of claim 9 also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Watson in view of Card in the manner proposed by the Examiner.

b. The Examiner's position and Appellants' rebuttal

i. The Examiner's position

In support of the rejection of claim 9, the Examiner has stated that (see § 4 on pages 2-3 of the final Office action; emphasis added):

Regarding claim 9, Watson discloses a bookbinding system, comprising: two or more sheets bound into a text body 15 having an exposed spine bounded by two exposed side hinge areas (not labeled, see figure 3); an adhesive dispenser (in the form of a roll, not shown, see column 2, lines 63-67) configured to apply a solid pressure sensitive adhesive film 40 between a cover 32 (see column 3, lines 5-13, substrate 12 may be made of a width sufficient to form cover 32) and the side hinge areas of the text body 15; and a cover binder (not shown, see column 4, lines 38-46 and column 5, line 65 to column 6, line 2) configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Watson does not disclose a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body. Card et al. teaches the use of a sheet binder configured to bind with an adhesive 3 two or more sheets 1 into an adhesively bound text body for the purpose of creating a bound text body that strengthens the binding of the final book. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the system of Watson with the sheet binder of Card et al. in order to have a bound book in which the sheets are more strongly bound together.

ii. Appellants' rebuttal: the cited references do not disclose or suggest the "adhesive dispenser" element of claim 9

Contrary to the Examiner's position, Watson does not teach or suggest an adhesive dispenser that is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of an adhesively bound text body, as recited in claim 9. Instead, Watson discloses that the text body is not bound with an adhesive until after the pressure sensitive adhesive strips 40 have been attached to the unbound sheets of the book 15. In particular, Watson explains that (col. 5, line 65 - col. 6, line 5; emphasis added):

In use, cover strips 41 are removed to expose the adhesive 40 which, on application of pressure following insertion of the book 15 therebetween as described earlier, bonds the sides of substrate 12 to the outer pages of the book 15. The application of heat and pressure to the center portion or base of substrate 12 activates the low tack adhesive comprising stripe 14 to complete the bond in the manner described heretofore.

The reference to the earlier description in the underlined portion of this explanation corresponds to col. 4, lines 37-38, where Watson explains that "the loose pages comprising the book 15 are placed, edge first, on adhesive strip 14."

In support of the rejection of claim 9, the Examiner has stated that Watson discloses an adhesive dispenser in col. 2, lines 63-67. This disclosure, however, merely states that the adhesive "binding means, which could be conveniently supplied in the form of a roll, would be cut to size at the time of use." This disclosure does not describe an adhesive dispenser that applies a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. Contrary to the Examiner's assumption, a roll of the binding means 10 is not configured to apply the binding means 10 to the loose pages of the book 15. Instead, some mechanism must manipulate the roll in order to apply the binding means 10.

Card does not make-up for Watson's failure to disclose or suggest an adhesive dispenser that is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of an adhesively bound text body, as recited in claim 9.

Card discloses a manually operated machine for the threadless binding of a book (see col. 3, lines 19-21). In accordance with Card's teachings, loose sheets 1 are held by a clamp (see FIG. 1) and shaped by hot plate sections 8, 9 to have a convex back edge (see FIG. 2). The convex back edge then is pressed against a support 3 that is formed of a lining material that is coated with a layer of melttable adhesive (see col. 3, lines 24-27), which is melted to adhere the support 3 to form the book body 1 (see FIG. 4, col. 4, lines 9-14). The support 3 additionally includes a pair of longitudinal elements 4 (e.g., paper strings) that are disposed on opposite sides of the convex back edge (see FIG. 3, col. 3, lines 27-32).

After the support 3 has been adhered to the loose sheets to form the book body 1, a case 20 is attached (presumably manually) to the body 1. Card discloses the attachment of the book body 1 to the case 20 as follows (see col. 4, lines 49-61, and FIG. 6; emphasis added):

...The elements 4 which are fixed to the book body, engage in the recesses or cavities 25 and cooperate with end papers which are pasted to the inside of the cover boards and to the adjacent sheets of the book body, in retaining the book body firmly within the case. The arrangement thus strengthens the book binding and serves to prevent forward sagging of the leaves of the book body, and thereby prolong the useful life and appearance of the binding. The binding serves to retain the

rounding at the back and front of the book which facilitates handling of the book and prevents the front of the book becoming flat or convex in form, due to sagging of the leaves.

In accordance with this disclosure, the book body 1 is secured to the case 20 by virtue of (1) the engagement of the longitudinal elements 4 in the cavities 25 that are formed on each side of the spine of the case 20 (see col. 4, lines 42-49, and FIG. 6), and (2) the attachment of the end papers to the inside of the cover boards 21, 22 and to the adjacent sheets of the book body 1.

Thus, Card's bookbinding system does not include an adhesive dispenser that is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. Instead, Card's manually operated bookbinding machine simply binds loose sheets into the book body 1 by melting the adhesive layer on the support 3 to the spine end of the loose sheets. Card's bookbinding machine does not attach a cover to the bound text body. However, in some undisclosed way, the case 20 is attached to the bound book body by pasting end papers to the inside cover boards and to the adjacent sheets of the book body (see col. 4, lines 49-61).

Thus, neither Watson nor Card discloses an adhesive dispenser that is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. Since the cited references do not disclose or suggest each and every one of the elements of claim 9, the rejection of claim 9 under 35 U.S.C. § 103(a) over Watson in view of Card should be withdrawn.

iii. Appellants' rebuttal: one skilled in the art would not have had any apparent reason to combine the cited references in the manner proposed by the Examiner

The rejection of claim 9 over Watson in view of Card also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Watson in view of Card in the manner proposed by the Examiner.

In particular, the Examiner has taken the position that one skilled in the art would have been motivated to attach Watson's cover to Card's book body 1 (which is bound by the support 3) "in order to have a bound book in which the sheets are more strongly bound together." Watson, however, already discloses a method of binding loose sheets into a text body. In particular, Watson discloses a cover 30 that includes a central stripe 41 of heat-

activated adhesive 13 flanked by adjacent stripes 41 of pressure sensitive adhesive 40 (see FIG. 7, col. 5, lines 58-64). In operation, the pressure sensitive adhesive strips 41 are attached to the unbound sheets of the book 15, and then unbound sheets of the book 15 are bound by melting the heat-activated adhesive (see col. 5, line 65 - col. 6, line 5). Watson's method allows a user to use a simple sequence of operations in order to (i) attach a cover to a set of loose unbound sheets and (ii) bind the loose unbound sheets.

One skilled in the art would not have had any apparent reason to apply Watson's cover 30 to Card's book body 1 (which is bound by the support 3). To the contrary, such a modification of Watson's teachings would defeat the readily apparent inherent advantage of Watson's method, which allows a user to both (i) attach a cover to a set of loose unbound sheets and (ii) bind the loose unbound sheets using a simple sequence of operations. In addition, the Examiner's proposed binding of Card's book body 1 to Watson's cover 30 would defeat the object of Card's teachings (i.e., to produce a perfectly bound book with a floating spine). In particular, the central stripe 41 of heat-activated adhesive 13 on Watson's cover 30 would adhere to the back edge of Card's book body 1 during cover attachment, thereby defeating Card's objective of producing a perfectly bound book with a floating spine.

Thus, both Watson and Card teach away from the Examiner's proposed modification of Watson's disclosure.

In addition, the motivation given by the Examiner in support of the combination of Watson and Card (i.e., "in order to have a bound book in which the sheets are more strongly bound together") would not have given one skilled in the art any apparent reason to combine the reference teachings in the manner proposed by the Examiner. In particular, the strength with which the sheets are bound together in Card's approach depends entirely on the binding strength of the sheets to the backing support 3; the sheet binding strength is independent of the type of cover that attached to Card's book body 15. Therefore, the use of Watson's cover 30 with Card's body would not produce "a bound book in which the sheets are more strongly bound together." Consequently, the rationale given by the Examiner in support of the rejection of independent claim 9 amounts to no more than a conclusory statement that does not have any rational underpinning that supports a rejection under 35 U.S.C. § 103. See *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 14 (U.S. Apr. 30, 2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006): "[R]ejections on obviousness grounds cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

iv. Conclusion

For at least the reasons explained above, the rejection of claim 9 under 35 U.S.C. § 103(a) over Watson in view of Card should be withdrawn.

2. Dependent claims 10, 21-24, 27-29, 36, 37, and 39

Each of claims 10, 21-24, 27-29, 36, 37, 39 incorporates the elements of independent claim 9 and therefore is patentable over Watson in view of Card for at least the same reasons explained above.

C. Rejection of claim 11 under 35 U.S.C. § 103(a) over Watson in view of Card and Nakamura

The Examiner has rejected claim 11 under 35 U.S.C. § 103(a) over Watson (U.S. 3,847,718) in view of Card (U.S. 3,739,412) and Nakamura (JP 05038891).

Claim 11 depends from independent claim 9. Nakamura does not make-up for the failure of Watson and Card to disclose or suggest the elements of independent claim 9 discussed above. Therefore, claim 11 is patentable over Watson in view of Card and Nakamura for at least the same reasons explained above in connection with independent claim 9.

Claim 11 also is patentable over Watson in view of Card and Nakamura for the following additional reasons.

Claim 11 recites that the adhesive dispenser comprises a plug-in cartridge housing.

In support of the rejection of claim 11, the Examiner has taken the position that (see § 18 on page 8 of the final Office action):

The modified invention of Watson does not disclose that the adhesive dispenser comprises a plug-in cartridge housing. Nakamura et al. teaches the use of an adhesive dispenser 33 that dispenses pressure sensitive adhesive tape 2, the dispenser in the form of a plug-in cartridge housing for the purpose of being able to cut and dispense the tape from the backbone attaching device with the ability to easily remove the cartridge from the device without hindrance by the adhesive tape.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the modified system of Watson with the plug-in cartridge of Card et al. in order to have an adhesive dispenser that allows for easy replacement of the adhesive tape.

Thus, the Examiner has relied on Nakamura to make-up for the acknowledged failure that Watson and Card do not disclose or suggest an adhesive dispenser that comprises a plug-in cartridge housing.

Contrary to the Examiner's position, however, Nakamura does not make-up for the failure of Watson and Card to disclose the elements of claim 11. In particular, Nakamura discloses an adhesive cartridge 33 (see, e.g., FIGS. 1 and 5) that is configured to apply a one-sided adhesive tape 2 to the spine edge of a set of loose sheets 5 in order to produce a bound text body, as shown in FIG. 11. Nakamura's adhesive cartridge 33 is not configured to apply the adhesive tape 2 between a cover and the side hinge areas of an adhesively bound text body.

Thus, none of the cited references discloses or suggests each and every one of the elements of claim 11. For at least this additional reason, the rejection of claim 11 under 35 U.S.C. § 103(a) over Watson in view of Card and Nakamura should be withdrawn.

D. Rejections of claims 12, 13, and 30 under 35 U.S.C. § 103(a) over Watson in view of Card, Nakamura, and Rossini

The Examiner has rejected claims 12, 13, and 30 under 35 U.S.C. § 103(a) over Watson (U.S. 3,847,718) in view of Card (U.S. 3,739,412), Nakamura (JP 05038891), and Rossini (U.S. 5,261,996).

1. Dependent claim 12

Claim 12 incorporates the elements of independent claim 9. Rossini does not make-up for the failure of Watson, Card, and Nakamura to disclose or suggest the elements of independent claim 9 discussed above. Therefore, claim 12 is patentable over Watson in view of Card, Nakamura, and Rossini for at least the same reasons explained above in connection with independent claim 9.

2. Dependent claim 13

Claim 13 incorporates the elements of independent claim 9. Rossini does not make-up for the failure of Watson, Card, and Nakamura to disclose or suggest the elements of independent claim 9 discussed above. Therefore, claim 13 is patentable over Watson in view of Card, Nakamura, and Rossini for at least the same reasons explained above in connection with independent claim 9.

The rejection of claim 13 under 35 U.S.C. § 103(a) over Watson in view of Card, Nakamura, and Rossini also should be withdrawn for the following additional reason.

Claim 13 depends from claim 12 and recites that the adhesive dispenser comprises a take-up spool disposed within the plug-in cartridge housing and configured to reel-in spent carrier ribbon.

The Examiner has acknowledged that neither Watson nor Card nor Nakamura discloses an adhesive dispenser that includes a take-up spool configured to reel-in spent carrier ribbon on which a solid pressure sensitive adhesive film was disposed, as recited in claim 13 (see § 20 on page 9 of the final Office action).

The Examiner has cited Rossini in an effort to make-up for this failure of the teachings of the other cited references. In particular, the Examiner has stated that "Rossini teaches the use of a supply spool 42 configured to support a roll of adhesive tape 34 with a carrier ribbon 48, and which uses a take-up spool 46 disposed within the housing 10 for the purpose of winding up the used carrier ribbon 48." Contrary to the Examiner's statement, however, Rossini does not teach that the take-up spool reels in the web material 34, which serves as the carrier ribbon on which the adhesive is disposed. Instead, Rossini teaches that the take-up reel 46 is used to wind the waste strip of a protective release layer 48 (which is separate and distinct from the adhesive carrying web material 34) that may be disposed on the adhesive side of the tape (see col. 8, lines 19-34).

3. Independent claim 30

Independent claim 30 recites:

Claim 30: A bookbinding system, comprising:
a sheet binder configured to bind two or more sheets
into a text body having an exposed spine bounded by two
exposed side hinge areas;

an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body, wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon, and the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon; and

a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

The rejection of independent claim 30 under 35 U.S.C. § 103(a) over Watson in view of Card, Nakamura, and Rossini should be withdrawn because Watson and Card, Nakamura, and Rossini, taken either alone or in any permissible combination, do not disclose or suggest all the elements of the claimed invention. The rejection of claim 30 also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Watson in view of Card, Nakamura, and Rossini in the manner proposed by the Examiner.

The Examiner has acknowledged that neither Watson nor Card nor Nakamura discloses an adhesive dispenser that includes a take-up spool configured to reel-in spent carrier ribbon on which a solid pressure sensitive adhesive film was disposed, as recited in claim 30 (see § 20 on page 9 of the final Office action).

The Examiner has cited Rossini in an effort to make-up for this failure of the teachings of the other cited references. In particular, the Examiner has stated that "Rossini teaches the use of a supply spool 42 configured to support a roll of adhesive tape 34 with a carrier ribbon 48, and which uses a take-up spool 46 disposed within the housing 10 for the purpose of winding up the used carrier ribbon 48." Contrary to the Examiner's statement, however, Rossini does not teach that the take-up spool reels in the web material 34, which serves as the carrier ribbon on which the adhesive is disposed. Instead, Rossini teaches that the take-up reel 46 is used to wind the waste strip of a protective release layer 48 (which is separate and distinct from the adhesive carrying web material 34) that may be disposed on the adhesive side of the tape (see col. 8, lines 19-34).

Moreover, none of the cited references discloses or suggests an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side

hinge areas of the text body. As explained above in connection with independent claim 9, neither Watson nor Card discloses an adhesive dispenser that is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. As explained above in connection with claim 11, Nakamura's adhesive cartridge 33 is not configured to apply the adhesive tape 2 between a cover and the side hinge areas of an adhesively bound text body. Rossini does not disclose or suggest anything that would have given one skilled in the art any apparent reason to apply his single-sided adhesive tape 34 between a cover and the side hinge areas of an adhesively bound text body using his system for guiding a web material to and along a vacuum wheel applicator (see, e.g., col. 1, lines 6-17).

Thus, none of the cited references discloses or suggest "the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon," as recited in claim 39. Consequently, there is no combination of the cited references that possibly could disclose or suggest such a feature. For at least this reason, the Examiner's rejection of claim 30 under 35 U.S.C. § 103(a) over Watson in view of Card, Nakamura, and Rossini should be withdrawn.

The rejection of claim 30 over Watson in view of Card, Nakamura, and Rossini also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Watson in view of Card, Nakamura, and Rossini in the manner proposed by the Examiner.

In particular, the Examiner has taken the position that one skilled in the art would have been motivated to attach Watson's cover to Card's book body 1 (which is bound by the support 3) "in order to have a bound book in which the sheets are more strongly bound together" (see, e.g., § 4 on page 3 of the final Office action). Watson, however, already discloses a method of binding loose sheets into a text body. In particular, Watson discloses a cover 30 that includes a central stripe 41 of heat-activated adhesive 13 flanked by adjacent stripes 41 of pressure sensitive adhesive 40 (see FIG. 7, col. 5, lines 58-64). In operation, the pressure sensitive adhesive strips 41 are attached to the unbound sheets of the book 15, and then unbound sheets of the book 15 are bound by melting the heat-activated adhesive (see col. 5, line 65 - col. 6, line 5). Watson's method allows a user to use a simple sequence of

operations in order to (i) attach a cover to a set of loose unbound sheets and (ii) bind the loose unbound sheets.

One skilled in the art would not have had any apparent reason to apply Watson's cover 30 to Card's book body 1 (which is bound by the support 3). To the contrary, such a modification of Watson's teachings would defeat the readily apparent inherent advantage of Watson's method, which allows a user to both (i) attach a cover to a set of loose unbound sheets and (ii) bind the loose unbound sheets using a simple sequence of operations. In addition, the Examiner's proposed binding of Card's book body 1 to Watson's cover 30 would defeat the object of Card's teachings (i.e., to produce a perfectly bound book with a floating spine). In particular, the central stripe 41 of heat-activated adhesive 13 on Watson's cover 30 would adhere to the back edge of Card's book body 1 during cover attachment, thereby defeating Card's objective of producing a perfectly bound book with a floating spine.

Thus, both Watson and Card teach away from the Examiner's proposed modification of Watson's disclosure.

In addition, the motivation given by the Examiner in support of the combination of Watson and Card (i.e., "in order to have a bound book in which the sheets are more strongly bound together") would not have given one skilled in the art any apparent reason to combine the reference teachings in the manner proposed by the Examiner. In particular, the strength with which the sheets are bound together in Card's approach depends entirely on the binding strength of the sheets to the backing support 3; the sheet binding strength is independent of the type of cover that attached to Card's book body 15. Therefore, the use of Watson's cover 30 with Card's body would not produce "a bound book in which the sheets are more strongly bound together." Consequently, the rationale given by the Examiner in support of the rejection of independent claim 9 amounts to no more than a conclusory statement that does not have any rational underpinning that supports a rejection under 35 U.S.C. § 103. See *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 14 (U.S. Apr. 30, 2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006): "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

For at least these reasons, the rejection of independent claim 30 under 35 U.S.C. § 103(a) over Watson in view of Card, Nakamura, and Rossini should be withdrawn.

Applicant : Raymond G. Schuder et al.
Serial No. : 10/820,649
Filed : April 7, 2004
Page : 16 of 22

Attorney's Docket No.: 10002621-2
Appeal Brief dated Sep. 15, 2008
Reply to final action dated Apr. 14, 2008

VIII. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

Date: September 15, 2008

/Edouard Garcia, Reg. No. 38,461/

Edouard Garcia
Reg. No. 38,461
Telephone No.: (650) 965-8342

Please direct all correspondence to:

Hewlett-Packard Company
Intellectual Property Administration
Legal Department, M/S 35
P.O. Box 272400
Fort Collins, CO 80528-9599

CLAIMS APPENDIX

The claims that are the subject of Appeal are presented below.

Claims 1-8 (canceled)

Claim 9 (previously presented): A bookbinding system, comprising:
a sheet binder configured to bind with an adhesive two or more sheets into an
adhesively bound text body having an exposed spine bounded by two exposed side hinge
areas;
an adhesive dispenser configured to apply a solid pressure sensitive adhesive film
between a cover and the side hinge areas of the text body; and
a cover binder configured to bind the cover to the side hinge areas of the text body by
applying pressure to the cover.

Claim 10 (original): The bookbinding system of claim 9, wherein the adhesive
dispenser is configured to apply a solid pressure sensitive adhesive film to the cover in a
series of spaced-apart strips.

Claim 11 (previously presented): The bookbinding system of claim 9, wherein the
adhesive dispenser comprises a plug-in cartridge housing.

Claim 12 (original): The bookbinding system of claim 11, wherein the adhesive
dispenser comprises a supply spool disposed within the plug-in cartridge housing and
configured to support a roll of pressure sensitive adhesive tape formed from a solid pressure
sensitive adhesive film disposed on a carrier ribbon.

Claim 13 (original): The bookbinding system of claim 12, wherein the adhesive
dispenser comprises a take-up spool disposed within the plug-in cartridge housing and
configured to reel-in spent carrier ribbon.

Claims 14-20 (canceled)

Claim 21 (previously presented): The bookbinding system of claim 9, wherein the adhesive dispenser applies the solid pressure sensitive adhesive film to the cover before the cover binder contacts the applied solid pressure sensitive adhesive to the side hinge areas of the text body.

Claim 22 (previously presented): The bookbinding system of claim 9, wherein the cover binder binds the cover to the spine of the text body by positioning a portion of the cover over the spine of the text body and applying pressure to the portion of the cover positioned over the spine of the text body.

Claim 23 (previously presented): The bookbinding system of claim 22, wherein the adhesive dispenser applies the solid pressure sensitive adhesive film as a single continuous strip with a width dimension that is wider than the exposed spine of the text body.

Claim 24 (previously presented): The bookbinding system of claim 22, wherein the adhesive dispenser applies the solid pressure sensitive adhesive film in a series of multiple strips over an area corresponding to the side hinge areas and the exposed spine of the text body.

Claim 25 (previously presented): A bookbinding system, comprising:
a sheet binder configured to bind two or more sheets into a text body having an exposed spine bounded by two exposed side hinge areas;
an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body, wherein the adhesive dispenser applies between the cover and the side hinge areas a solid pressure sensitive adhesive film that comprises a pressure sensitive adhesive composition laminated to a hot melt adhesive film; and
a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Claim 26 (previously presented): The bookbinding system of claim 25, wherein:

the adhesive dispenser applies the solid pressure sensitive adhesive film with the hot melt adhesive film in contact with the side hinge areas and the exposed spine of the text body;

the sheet binder melts the hot melt adhesive film to bind the two or more sheets into the text body; and

the cover binder binds the cover to the side hinge areas of the text body by disposing the cover over the text body and applying pressure to the cover to activate the pressure sensitive adhesive composition.

Claim 27 (previously presented): The bookbinding system of claim 9, wherein the cover binder contacts the side hinge areas to the applied solid pressure sensitive adhesive film.

Claim 28 (previously presented): The bookbinding system of claim 9, wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive.

Claim 29 (previously presented): The bookbinding system of claim 28, wherein the adhesive dispenser dispenses from the roll a solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon.

Claim 30 (previously presented): A bookbinding system, comprising:
a sheet binder configured to bind two or more sheets into a text body having an exposed spine bounded by two exposed side hinge areas;

an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body, wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon, and the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon; and

Applicant : Raymond G. Schuder et al.
Serial No. : 10/820,649
Filed : April 7, 2004
Page : 20 of 22

Attorney's Docket No.: 10002621-2
Appeal Brief dated Sep. 15, 2008
Reply to final action dated Apr. 14, 2008

a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Claims 31-35 (canceled)

Claim 36 (previously presented): The bookbinding system of claim 9, further comprising a roll of the solid sheet adhesive loaded in the adhesive dispenser.

Claim 37 (previously presented): The bookbinding system of claim 9, wherein the cover binder positions the cover over the exposed side hinge areas and the exposed spine of the text body and applies pressure to the positioned cover to activate the pressure sensitive adhesive film.

Claim 38 (previously presented): The bookbinding system of claim 37, wherein the cover binder applies pressure to the positioned cover to activate the pressure sensitive adhesive film without applying heat.

Claim 39 (previously presented): The bookbinding system of claim 10, wherein the adhesive dispenser applies the spaced-apart strips of the solid pressure sensitive adhesive film respectively over areas of the cover corresponding to the spine and the side hinge areas of the text body.

Applicant : Raymond G. Schuder et al.
Serial No. : 10/820,649
Filed : April 7, 2004
Page : 21 of 22

Attorney's Docket No.: 10002621-2
Appeal Brief dated Sep. 15, 2008
Reply to final action dated Apr. 14, 2008

EVIDENCE APPENDIX

There is no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the pending appeal. Therefore, no copies are required under 37 CFR § 41.37(c)(1)(ix) in the pending appeal.

Applicant : Raymond G. Schuder et al.
Serial No. : 10/820,649
Filed : April 7, 2004
Page : 22 of 22

Attorney's Docket No.: 10002621-2
Appeal Brief dated Sep. 15, 2008
Reply to final action dated Apr. 14, 2008

RELATED PROCEEDINGS APPENDIX

Appellant is not aware of any decisions rendered by a court or the Board that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Therefore, no copies are required under 37 CFR § 41.37(c)(1)(x) in the pending appeal.